

Attorney Docket No. 32251-70829
PATENT



JUN 25 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David C. May Confirmation No. 9351
Serial No.: 09/166,625 Art Unit: 1771
Filed: October 5, 1998 Examiner: Cheryl Ann Juska

For: HIGHLY DRAPABLE PROTECTIVE COVER HAVING ULTRATHIN
NON-WOVEN ABSORBENT LAYER

REQUEST FOR SUPERVISORY REVIEW OF OFFICE ACTION

Honorable Commissioner for
Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the office action mailed June 18, 2004 reopening prosecution after applicant filed an appeal and brief, but before forwarding the application to the Board of Appeals and Interferences.

The Manual of Patent Examining Procedure (MPEP) at Sections 1208.01 and 10002.02(d) require the approval of the supervisory primary examiner for reopening prosecution after the filing of an appeal. A notice of appeal was filed on February 3, 2004 and the appeal brief was filed on April 2, 2004. The office action at page 7 is signed by "Cheryl A. Juska Primary Examiner" and identifies, in the second paragraph on that page, "the examiner's supervisor, Terrel Morris...." There is no signature of the supervisor on the office action and, in view of the above-noted requirements stated in the MPEP and the following brief remarks, it is requested that the supervisor review the office action and pass the application to issue.

Undersigned counsel has not fully reviewed the prior art and this submission is not a response to the merits of the office action. This communication is submitted to permit the supervisor to review and decide the propriety of the above-noted office action in accordance with the MPEP.

To assist with that review it is, respectfully, submitted that the office action is in error in the following aspects.

The office action rejection of claims 1, 3, 7, 8, 10, 15 and 16 begins by stating the rejection is based on Garland (U.S. Patent No. 5,266,390) in view of Reaves (U.S. Patent No. 5,368,912) and Trosper et al (U.S. Patent No. 5,761,853). The body of the rejection acknowledges that Garland's disclosure is inoperable at least with respect to layer thickness.¹ Two additional prior art references (U.S. Patent Nos. 4,704,323 and 4,441,228) are relied on to supplement Garland and it is concluded that "it would have been obvious to one skilled in the art to employ a thickness within the range claimed by applicant...."

The combination of five prior art references to reach a conclusion of obviousness compounds a determination of whether there is a proper combination. The reference to two prior art references to overcome the inoperability of Garland is not based on any explanation of where in any of Garland or U.S. Patent Nos. 4,704,323 and 4,441,228 there is motivation for employing the thickness in either '323 or 228 in Garland. This application has already had seven office actions on the merits (February 4, 1999, October 7, 1999, June 21, 2000, March 14, 2001, February 26, 2002, October 22, 2002 and November 4, 2003), two interviews (April 3, 2000 and July 15, 2003) and applicant has filed an appeal and brief. Applicant has consistently tried to advance the prosecution of this application. The use of five references to justify the initial rejection with additional references added for other rejections (the rejection of claims 9 and 17 adds two additional references) does not appear proper at this stage of prosecution.

None of the references teach or suggest the subject matter as whole. Rather, the rejection combines multiple prior art references and urges that such combination would have been obvious. The office action is an attempt to find the pieces of the invention (this is not to be construed that the present prior art teaches or suggests all pieces of applicant's claims) and whether the individual differences themselves would have been obvious rather than properly determining whether the claimed invention as a whole would have been obvious. See, for example, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPT 871 (Fed.Cir. 1983) cited and Section 2141.02 of the MPEP (second paragraph).

¹ At page 4 of the office action it is concluded that "one of ordinary skill in the art would recognize that the thickness disclosed by Garland to [sic] is incorrect."

The above are just examples of reasons why the office action should not be approved by the supervisor. Supervisory review of the office action is requested.

The examiners and/or supervisor are invited to telephone the undersigned if there are any outstanding issue(s) which can be promptly resolved in order that the application be forwarded for issuance as a patent.

Respectfully submitted,

BARNES & THORNBURG

A handwritten signature in black ink, appearing to read "Richard B. Lazarus". The signature is fluid and cursive, with the first name "Richard" and last name "Lazarus" clearly distinguishable.

Richard B. Lazarus

Registration No. 48,215

Tel. No. (202) 289-1313